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EXAMINER	
LIOU, ERIC	

ART UNIT	PAPER NUMBER
3628	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/823,439	TEICHGRABER ET AL.	
	Examiner	Art Unit	
	Eric Liou	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/13/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 1 recites the limitation "the pertinent identification code" in step (c). There is insufficient antecedent basis for this limitation in the claim. The Examiner interprets "the pertinent identification code" to be "the identification code" recited in step (b).

4. Claim 3 recites the limitation "correct address information" in line 3. There is insufficient antecedent basis for this limitation in the claim. The Examiner interprets "correct address information" to be the "new address information" recited in claim 1. In addition, the claim is indefinite because it unclear what the course of action is when the detected address information does not contain a first postal code.

5. As per claim 9, the phrases "adapted to" and "capable of" are used, rendering the claims and their dependencies indefinite because the system does not actually perform the purported limitations as currently claimed. Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. *See e.g.* MPEP § 2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]"; and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir.

2006) ("As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted."). *See also* MPEP § 2111.04. For the purposes of examination, the examiner requests applicant to amend the claims to positively recite that the system actually performs the purported limitations.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Didriksen, PCT International Application WO 00/00300.

8. As per claim 1, Didriksen discloses a method for processing mailpieces comprising:

(a) detecting information present on at least one surface of a mailpiece and applying a machine-readable identification code onto the mailpieces (Didriksen: pg. 3, lines 20-24; pg. 7, lines 15-20; pg.8, lines 1-3; pg. 25, lines 17-19; pg.26, lines 9-13; pg. 27, lines 20-22);

(b) transmitting the detected information and the identification code to an interface computer (Didriksen: pg. 3, lines 25-26; pg. 7, lines 26-30; pg. 25, lines 19-22);

(c) storing the detected information and the pertinent identification code as data (Didriksen: pg. 7, lines 15-20 and 30-33; pg. 25, lines 21-22);

(d) accessing the stored data (Didriksen: pg. 7, lines 15-20 and 30-33; pg. 26, lines 3-5);

(e) determining address information on the basis of the detected and stored information (Didriksen: pg. 7, lines 15-20 and 26-30; pg. 8, lines 5-6);

(f) comparing the detected address information with address information present in a database (Didriksen: pg. 11, lines 16-27; pg. 25, lines 31-34 – pg. 26, lines 1-5);

(g) associating the detected address information with new address information on the basis of the comparison that has been carried out (Didriksen: pg. 11, lines 16-27);

(h) transmitting the associated new address information and the identification code to the interface computer (Didriksen: pg. 7, lines 26-30; pg. 11, lines 16-27);

(i) detecting the identification code applied onto the mailpieces (Didriksen: pg. 8, lines 1-3); and,

(j) applying the new address information onto the mailpiece, whereby the new address information is applied as a function of the identification code (Didriksen: pg. 11, lines 16-27).

9. As per claim 2, Didriksen discloses the method of claim 1 as described above. Didriksen further discloses processing the mailpieces according to a two-stage process, comprising preliminarily sorting the mailpieces in a first sorting step and (Didriksen: pg. 10, lines 15-20; pg. 27, lines 29-32) separately, sorting the mailpieces into smaller units in a second sorting step (Didriksen: pg. 10, lines 20-26; pg. 15, lines 16-25; pg. 28, lines 4-17), and detecting the information present on the surface of the mailpiece and converting the address information present on the mailpiece into the new address information during the first sorting step (Didriksen: pg. 11, lines 16-27; pg. 25, lines 31-34 – pg. 26, lines 1-13; pg. 27, lines 15-22).

10. As per claim 3, Didriksen discloses the method of claim 1 as described above. Didriksen further discloses ascertaining whether the detected address information contains a first postal code (Didriksen: pg. 3, lines 20-21; pg. 8, lines 1-3; pg. 25, lines 17-23), and converting the first

postal code into a postal code that matches correct address information (Didriksen: pg. 11, lines 16-27).

11. As per claim 4, Didriksen discloses the method of claim 1 as described above. Didriksen further discloses applying the new address information onto the mailpiece in coded form (Didriksen: pg. 11, lines 16-27).

12. As per claim 5, Didriksen discloses the method of claim 4 as described above. Didriksen further discloses the address information comprises a barcode (Didriksen: pg. 26, lines 12-13).

13. As per claim 6, Didriksen discloses the method of claim 4 as described above. Didriksen further discloses the address information is at least partially in plain text (Didriksen: pg. 25, lines 17-19).

14. As per claim 7, Didriksen discloses the method of claim 2 as described above. Didriksen further discloses carrying out at least one sorting step as a function of the new address information (Didriksen: pg. 27 lines 24-33 – pg. 28, lines 1-17).

15. As per claim 8, Didriksen discloses the method of claim 1 as described above. Didriksen further discloses transporting the mailpieces at least over a segment as a function of the new address information (Didriksen: pg. 10, lines 15-26; pg. 27, lines 24-33 – pg. 28, lines 1-17).

16. As per claim 9, Didriksen discloses a device for processing mailpieces comprising:

a) a detection device capable of detecting information present on at least one surface of the mailpieces (Didriksen: pg.19, lines 13-15; pg. 25, lines 17-19) and a printer to apply a machine-readable identification code onto the mailpieces (Didriksen: pg. 26, lines 9-13 – The Examiner notes, printing a code implies a printer.);

b) an interface computer comprising memory for storing the detected information (Didriksen: Figure 14, "207"; pg. 19, lines 9-11; pg. 25, lines 21-22; pg. 26, lines 5-9);

c) processing stations comprising a processor capable of accessing the stored detected information and the appertaining stored identification codes, and capable of determining address information on the basis of the stored detected information (Didriksen: Figure 14, "207" and "208"; pg. 19, lines 16-19; pg. 25, lines 17-22; pg. 26, lines 3-5);

d) a database comprising address information and a comparison unit adapted to compare the detected address information with address information present in the database (Didriksen: pg. 25, lines 31-34 – pg. 26, lines 1-5),

e) a processor programmed to associate the detected address information with new address information on the basis of a comparison of the detected address information with the address information that is present in the database (Didriksen: Figure 14, "207" and "208"; pg. 11, lines 16-27);

f) a transmitter capable of transmitting the new address information and the identification code from the processing stations to the interface computer (Didriksen: Figure 2, "207"; pg. 30, lines 24-31; pg. 35, lines 5-6) and,

g) a device capable of detecting the identification code applied onto the mailpieces and capable of applying the new address information onto the mailpiece as a function of the identification code (Didriksen: pg. 11, lines 16-27; pg. 26, lines 9-13).

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Allport et al., U.S. Patent No. 6,865,561, drawn to a closed system meter having address correction capabilities. Moore et al., U.S. Patent No. 7,051,007, drawn to an apparatus and method for printing an information –based indicia. Kiani et al., U.S. Patent No., 5,893,464, drawn to a method and apparatus for sorting mailpieces.

The Examiner has cited particular portions of the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the Applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Liou whose telephone number is 571-270-1359. The examiner can normally be reached on Monday - Friday, 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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PRIMARY EXAMINER